UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 May 2008</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/08

has been entered.

Response to Arguments

2.   Applicant's arguments filed 5/22/08 have been fully considered but they are not

persuasive.

The applicant argues on page 11 of the response in essence that:

Sinofsky '178 fails to teach storing one or more document indicia as separate sub-

images in the single file in the native format.

a.   In response to applicant's arguments against the references individually,

one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986). Warmus '149 discloses storing one or more

document indicia (col. 9, lines 57-61, personalized .information, variable image,

or the like) as separate sub-images in a native format (col. 7, lines 1-6, variable page files).

The applicant argues on pages 11 and 12 of the response in essence that: Warmus '149 teaches against a combination wherein a word processing program is used to produce books as taught by Sinofsky '178.

      b.   Sinofsky '178 is relied on to teach a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files). Merely because Sinofsky '178 states that the file **may** be a word document (only one example) does not mean the file must be a word document file. Furthermore, Sinofsky '178 is only a secondary reference utilized to modify the file of Warmus '149. Therefore, regardless of any disadvantages of word processing software stated by Warmus '149, Sinofsky '178 is relied on only to teach a single file that contains sub-images.

Claim Objections

3.   Claim 9 is objected to because of the following informalities: In line 1, replace "subimages" with "sub-images". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-9, 11, 13, 14 and 18-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Warmus '149 in view of Sinofsky '178.

Referring to **claim 1**, Warmus '149 discloses in an image rendering environment,

a method for dynamically adding one or more document indicia to a document when

rendering the document, the method comprising: providing a rendering job in a native

format that supports at least one of (i) multiple pages, and (ii) multiple images (col. 7,

lines 1-6, page description language);

storing one or more document indicia (col. 9, lines 57-61, personalized

information, variable image, or the like) as separate sub-images in a native format (col.

7, lines 1-6, variable page files);

correlating one or more pages of the document with one or more of the sub-

images (col. 7, lines 24-36, master and variable page files merged);

defining an ordered subset of the sub-images to apply to the document (col. 7,

lines 6-10, press command file specifies the manner in which the master and variable

files are to be merged); and

using a process to associate the one or more sub-images with one or more of the

pages of the document when rendering the document, wherein the process is one of (i)

an overlay process, (ii) an underlay process, and (iii) a composite process (col. 20, lines

1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly a single file document containing separate sub-images.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file. The motivation for doing so would have been to maintain the integrity of the comprehensive file. Therefore, it would have been obvious to combine Sinofsky '178 with Warmus '149 to obtain the invention as specified in claim 1.

Referring to **claim 2**, Warmus '149 discloses wherein the native format is one of:

(i) a tagged image file format; and

(ii) a portable document format (col. 4, lines 21-31, TIFF file).

Referring to **claim 3**, Warmus '149 discloses wherein the document indicia is disbound from page data of the rendering job (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to **claim 4**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises a linking the one or more pages in a next list (col. 7, lines 6-10, press command file specifies the manner in which the master and variable files are to be merged).

Referring to **claim 5**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises a sub-chaining the one or more sub-images from page images by a sub list (col. 7, lines 6-10, press

command file specifies the manner in which the master and variable files are to be merged).

Referring to **claim 6**, Warmus '149 discloses wherein correlating one or more pages of the document with one or more of the sub-images comprises sub-chaining the one or more sub-images within sub-images (col. 11-12, lines 62-67, 1-22, object inserted defined by curser, user can insert multiple objects).

Referring to **claim 7**, Warmus '149 discloses wherein defining an ordered subset of the sub-images comprises creating a set of instructions in one of

(i) a dynamic manner, and

(ii) a static manner (col. 20, lines 49-54).

Referring to **claim 8**, Warmus '149 discloses wherein the overlay process includes applying an overlay on top of one of:

(i) a page image; and

(ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the master pages).

Referring to **claim 9**, Warmus '149 discloses wherein all the sub-images are in the native format (col. 4, lines 21-31, TIFF file).

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

Referring to **claim 11**, Warmus '149 discloses wherein the native format is an image format (col. 4, lines 21-31, TIFF file).

Referring to **claim 13**, Warmus '149 discloses in a printing environment, a

method for adding document indicia when printing an image without the use of a printer

driver, the method comprising:

using a multi-subfile extension (Fig. 5, col. 11, lines 18-29, file 130 includes file

portions) to represent multiple sub-images of a TIFF image, wherein data of the TIFF

image is not converted into printing instructions by an application (col. 23, lines 21-23,

files 122, 137, and 138 preprocessed to TIFF format);

using an extension to group and locate the sub-images on a page (Fig. 5, col. 11,

lines 18-29, file 130 includes file portions);

providing one or more electronic tags to perform at least one of:

supporting an overlay of the multiple sub-images on the page (col. 20, lines 1-10,

overlay the variable pages on the master pages).;

supporting an underlay of the multiple sub-images on the page;

supporting a composite of the multiple sub-images on the page;

specifying a merge order of the multiple sub-images on the page;

specifying a location for merging the multiple sub-images on the page; and

specifying any scaling of the multiple sub-images; and

selectively rendering the TIFF image based on the electronic tags (col. 23, lines

21-35, process the pages for printing).

Warmus '149 does not disclose expressly a single file document containing

separate sub-images.

Sinofsky '178 discloses a single file document containing separate sub-images (col. 3, lines 6-19, compound document that contains sub-files).

At the time of the invention, it would have obvious to a person of ordinary skill in the art to incorporate multiple files into one comprehensive file. The motivation for doing so would have been to maintain the integrity of the comprehensive file. Therefore, it would have been obvious to combine Sinofsky '178 with Warmus '149 to obtain the invention as specified in claim 13.

Referring to **claim 14**, see the rejection of claim 8 above.

Referring to **claim 18**, see the rejection of claim 12 above.

Referring to **claim 19**, see the rejection of claim 1 above.

Referring to **claim 20**, see the rejection of claim 2 above.

Referring to **claim 21**, see the rejection of claim 4 above.

Referring to **claim 22**, see the rejection of claim 7 above.

Referring to **claim 23**, see the rejection of claim 8 above.

6.   Claims 10, 12, 15-17, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus '149 and Sinofsky '178 as applied to claims 1, 8, 13, and 23 above, and further in view of well known prior art.

Referring to **claim 10**, Warmus '149 discloses wherein the overlay process includes applying an overlay on top of one of:

(i) a page image; and

(ii) another sub-image (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly applying an underlay process. Official Notice is taken that it is well known and obvious in the art to apply an underlay (See MPEP 2144.03). The motivation for doing so would have been to retain the information of the master page of the overlapping region as opposed to the variable page. Therefore it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 10.

Referring to **claim 12**, Warmus '149 discloses wherein using a process to associate the one or more sub-images with one or more of the pages of the document when rendering the document (col. 20, lines 1-10, overlay the variable pages on the master pages).

Warmus '149 does not disclose expressly the process occurring within a printing device rending and printing the document without rasterization and without the use of a printer driver.

Official Notice is taken that it is well known and obvious for a printer to render and print a document without rasterization or without the use of a printer driver (See MPEP 2144.03). The motivation for doing so would have been to reduce the processing required for the printer to print a document. Further, a bitmap printer is a common type of printer known in the art that receives a bitmap from a host and processes the image without requiring rasterizing the image or needing a print driver.

Therefore, it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 12.

Referring to **claim 15**, Warmus '149 discloses the overlay but does not disclose expressly overlaying a form, page numbering, header, footer, or caption. Official Notice is taken that it is well known and obvious in the art to overlay one of:

(i) a form;

(ii) a page numbering;

(iii) a header;

(iv) a footer; and

(v) a caption (See MPEP 2144.03).

The motivation for doing so would have been to provide useful information on all printed pages of a document. Therefore, it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 15.

Referring to **claim 16**, see the rejection of claim 10 above.

Referring to **claim 17**, Warmus '149 discloses adding document indicia to a document but does not disclose expressly a watermark. Official Notice is taken that it is well known and obvious in the art to utilize a watermark when printing a document (See MPEP 2144.03). The motivation for doing so would have been to protect a document from counterfeit. Therefore it would have been obvious to combine well known prior art with Warmus '149 to obtain the invention as specified in claim 17.

Referring to **claim 24**, see the rejection of claim 15 above.

Referring to **claim 25**, see the rejection of claim 17 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K Huntsinger/
Examiner, Art Unit 2625

/David K Moore/
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